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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/725,713	Applicant(s) NII, NAOAKI	
	Examiner Yogesh C. Garg	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/31/2006 has been entered.

Response to Amendment

2. Applicant has amended claim 1. Currently claims 1-23 are pending for examination. Claims 24-28 were previously canceled and claims 29-58 were previously withdrawn.

Response to Arguments

3.1. The applicant argues (see arguments filed 3/31/2006) that the Office action rejection of claims 1-23 under 35 USC 112, first paragraph for lack of descriptive support for the limitation, "wherein the content is not provided from the integrated circuit cards " is on literal basis and does not establish a prima facie case. Applicant's arguments have been fully considered but they are not persuasive for following reasons:

See MPEP 2173.05(i) Negative Limitations:

" Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.

See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. *Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.* "

The applicant's original disclosure neither shows an evidence of positively reciting the negative limitation, " wherein the content is not provided from the integrated circuit cards" (see claims 1 & 19), nor it recites positively this limitation as an alternative element including other alternatives. The applicant's specification does not disclose enablement for stopping downloading/providing the content from an integrated circuit card if it is possible to do so.

The specification, as originally filed discloses, as an example, that the content provider may be one of many possibilities, see Specification, page 5, paragraph 0016, " The content provider might be a database at a kiosk which includes the host and user IC card interfaces. Alternatively, the content provider might be remote from the kiosk. Further, the content provider might be a personal computer, a notebook computer, a

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wireless personal terminal, or any other processor system having sufficient memory. “.

It also includes a processor system having sufficient memory and an IC card is a processor system which can have sufficient memory to store data which can be transmitted to another computer readable medium. Thus, neither the specification states a definite exclusion of IC card as content provider nor it provides a firm basis for the exclusion of IC card as content provider.

Further, the negative limitation, as discussed above, renders the claim indefinite because it appears to be an attempt to claim the invention by excluding what the inventors did not invent, rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). As mentioned above, the applicant's specification does not disclose enablement for stopping downloading/providing the content from an integrated circuit card if it is possible to do so.

3.2. The applicant argues, see pages 18-19, “ Neither references, however, teach, disclose, or otherwise suggest the control unit as recited in the rejected claims.....Neither the “441 patent nor the ‘640 patent suggest a control unit that compares a first authorization information with a second authorization information, that upon being compatible, actuates an output device to provide content of at least one multimedia file selected by the input device” . The examiner respectfully disagrees. ‘640 Patent to Ramachandran et al. does disclose a control unit, see Fig.1-a computer processor 12, which actuates downloading of multimedia files through various output

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means (see col.8, lines 53-65) and also teaches comparing a first authorization information with a second authorization information and only when these two information are determined compatible downloading of multimedia files is allowed (see col.12, line 64-col.13, line 20. The customer obtains a license code from a licensing entity prior to downloading the digital content and then at the time of downloading multimedia files he is required to enter this license code via an input device which is validated by comparing the entered code with that available with the licensing authority and only when the two codes are found compatible downloading of digital/multimedia files is permitted. Here, the first authorization information corresponds to the license code generated by the licensing entity and the second authorization information corresponds to the code input /retrieved from a card by a card reader and only when they are determined compatible downloading of files is allowed.

The applicant argues, see page 19, that as per his disclosure " there is no need for browser software in the terminal for downloading purposes. So instead of surfing on the spot, the only active operation the user has to do is to insert a card or information relating to the card, in the terminal". The applicant further argues that 'patent 640 does not disclose this. The examiner again disagrees for two reasons:

(i) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., " there is no need for browser software in the terminal for downloading purposes. So instead of surfing on the spot, the only active operation the user has to do is to insert a card or information relating to the card, in the terminal") are not recited in the rejected

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claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(ii) '640 patent does disclose (col.5, lines 6-15) , similar to the applicant's invention (Specification, page 6, lines 11-18), that ATM, corresponding to the kiosk terminal in the applicant's invention has the capability to acquire and store the digital files so that at the time of the customer's requirement they can be selected and downloaded from the stored files in ATM.

The applicant argues, see pages 19-20, " While the '441 patent may be interpreted as having a first and second integrated circuit card, there is no actuation of the output device as recited in the rejected claims.....Merely applying the dual card functionality of the '441 patent with the control unit of the '640 patent as recited in the rejection does not teach or even suggest the subject matter of the rejected claims". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, '640 patent, discloses all the limitations of claims 1 and 19, as submitted in the Final office action, pages 6-9, mailed on 10/11/2005 and further substantiated above except:

" another integrated circuit card interface for receipt of a host integrated circuit card containing authorization information and the control unit, responsive to responsive to the host and user integrated circuit cards being received in the integrated circuit card

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interfaces which compares the authorization information from both the host and the user cards and when these two authorization information found to be compatible actuates said output device to provide the digital multimedia content.”. In order to overcome this deficiency, the examiner combined the teachings of ‘441 patent (see at least Fig.1 and col.7, line 35-col.8, line 10. Fig.1 shows two interfaces for receiving integrated circuit cards, that is reference numbers “24” and “26” one from the host, that is main card I receptacle 24 and another from the user, that is the parent card in receptacle 26 and reference number “10”, that is the decoder unit corresponds to the claimed control unit. In Handelman, decoder unit 10, that is the control unit in response to receiving both the cards inside their receptacles compares the authorization information from both the cards and when the authorized information is compatible, that is it actuates the output device to display TV shows, depending if the parental card is there then all programs can be shown and if parent card is not there then only unrestricted programs are viewable). In view of ‘441 patent, at the time of the applicant’s invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Ramachandran of identifying the user for providing multimedia content files to have included the system of ‘441 patent in order to be able to control providing multimedia files so that the children or other users are not able to view data restricted for them as taught in ‘patent 441.

3.2. Since claim 1 is amended, objection to claim is withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.1. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation, " the content is not provided from the integrated circuit cards", as mentioned in the earlier Office action was not disclosed in the specification originally filed on 11/30/2000. The specification, as originally filed discloses , as an example, that the content provider may be one of many possibilities, see Specification, page 5, paragraph 0016, " The content provider might be a database at a kiosk which includes the host and user IC card interfaces. Alternatively, the content provider might be remote from the kiosk. Further, the content provider might be a personal computer, a notebook computer, a wireless personal terminal, or any other processor system having sufficient memory. ". It also includes any processor system having sufficient memory and a IC card is a processor system can have sufficient memory to store data which can be transmitted to another computer readable medium. Thus, neither the specification states a definite exclusion of IC card as content

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provider nor it provides a firm basis for the exclusion of IC card as content provider. See MPEP 2173.05 (i).

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran et al. (US Patent 6,298,441), hereinafter referred to as Ramachandran in view of Handelman et al. (US Patent 6,298,441), hereinafter, referred to as Handelman.

Note: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Referring to claim 1. Ramachandran discloses a multimedia content delivery system. Ramachandran discloses a control unit, see Fig.1-a computer processor 12, which actuates downloading of multimedia files through various output means (see col.8, lines 53-65) and also teaches comparing a first authorization information with a second authorization information and only when these two information are determined compatible downloading of multimedia files is allowed (see col.12, line 64-col.13, line 20. The customer obtains a license code from a licensing entity prior to downloading the digital content and then at the time of downloading multimedia files he is required to enter this license code via an input device which is validated by comparing the entered code with that available with the licensing authority and only when the two codes are found compatible downloading of digital/multimedia files is permitted. Here, the first authorization information corresponds to the license code generated by the licensing entity and the second authorization information corresponds to the code input /retrieved from a card by a card reader and only when they are determined compatible downloading of files is allowed. Ramachandran also discloses (see at least col.5, lines 6-15) , similar to the applicant's invention (Specification, page 6, lines 11-18), that ATM, corresponding to the kiosk terminal in the applicant's invention has the capability to acquire and store the digital files so that at the time of the customer's requirement they can be selected and downloaded from the stored files in ATM.). The said system comprising:

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a content provider providing multimedia files (see at least: col. 3, line15-col.4, line 36, wherein ATM is a content provider providing multimedia files including sound recordings, images, TV shows, magazines, newspapers, games, etc.).,

a integrated circuit card interface for receipt of a user integrated circuit card containing authorization information (see at least col.7, lines 23-29, which discloses a card reader 20 for receipt of an user smart card to be used to identify a user along with other information such as his accounts. Note: Addressing the card reader or the card as first or second does not add any patentable or novelty because that does not change either the structure or the functions);

an input device for selecting at least one multimedia file from the plurality of multimedia files (see at least: col. 4, lines 37-59).,

an output device for providing the content of an authorized multimedia file provided by the content provider to a user of the user integrated circuit card (see at least: col. 4, lines 37-59, col.7, lines 23-42 which teach reading the information from the user's smart card to authorize him to provide digital content/information)., and

a control unit (Ramachandran: "computer processor 12"), for actuating said output device to provide the content of a multimedia file from the content provider selected by said input device under control of authorization information read from the user's smart card as already described above) and wherein the content is not provided from an integrated circuit card (Ramachandran: Figure 1).

Ramachandran does not disclose another integrated circuit card interface for receipt of a host integrated circuit card containing authorization information and the

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control unit, responsive to responsive to the host and user integrated circuit cards being received in the integrated circuit card interfaces which compares the authorization information from both the host and the user cards and when these two authorization information found to be compatible actuates said output device to provide the digital multimedia content.

However, in the same field of endeavor of allowing controlled access to downloadable digital information from a content provider, Handelman discloses another integrated circuit card interface for receipt of a host integrated circuit card containing authorization information and the control unit, responsive to the host and user integrated circuit cards being received in the integrated circuit card interfaces which compares the authorization information from both the host and the user cards and when these two authorization information found to be compatible actuates said output device to provide the digital multimedia content (see at least Fig.1 and col.7, line 35-col.8, line 10. Fig.1 shows two interfaces for receiving integrated circuit cards, that is reference numbers "24" and "26" one from the host, that is main card I receptacle 24 and another from the user, that is the parent card in receptacle 26 and reference number "10", that is the decoder unit corresponds to the claimed control unit. In Handelman, decoder unit 10, that is the control unit in response to receiving both the cards inside their receptacles compares the authorization information from both the cards and when the authorized information is compatible, that is it actuates the output device to display TV shows, depending if the parental card is there then all programs can be shown and if parent card is not there then only unrestricted programs are viewable). In view of Handelman,

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at the time of the applicant's invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Ramachandran of identifying the user for providing multimedia content files to have included the system of Handelman in order to be able to control providing multimedia files so that the children or other users are not able to view data restricted for them as taught in Handelman.

Referring to claim 2, Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a multimedia terminal having said content provider, said first integrated circuit card interface said control unit therein enclosed therein (Ramachandran: Fig. 2).

Referring to claims 3-4. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises an audio and video output device (Ramachandran: col. 7, lines 49-59).

Referring to claim 5. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises a communication link permitting downloading of the selected multimedia file in electronic form (Ramachandran. col. 7, lines 49-59).

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Referring to claim 6. Ramachandran in view of Handelman discloses a system according to claim 5 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said communication link is a wireless communication link (Ramachandran : col. 4, lines 37-49).

Referring to claims 7-8. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said input device, said output device, and said control unit comprise a Laptop computer and a wireless personal terminal (Ramachandran: col. 4, lines 37-49).

Referring to claim 9. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider comprises a server (Ramachandran'. Fig. 1).

Referring to claim 10. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider further comprises a mainframe computer coupled to said server (Ramachandran: Fig. 1)

Referring to claim 11. Ramachandran in view of Handelman discloses a system

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according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a server connected to said content provider (Ramachandran : Fig. 1).

Referring to claim 12. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a mainframe computer connected to said server (Ramachandran: Fig. 1).

Referring to claims 13-14. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said multimedia files comprise audio and video media (Ramachandran: abstract).

Referring to claims 15-18. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said video media comprises text, books, newspapers and games (Ramachandran: col. 6, lines 53-62).

Referring to claims 19-23, their limitations are closely parallel to the limitations of claims 1-5 and are therefore rejected under the same rationale as set forth above in claims 1-5.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Publication 2001/0047223 A1 to Metcalf et al. discloses a method and system of purchasing products from vending machines wherein the products include age restricted items and therefore includes issuing a first integrated circuit card (type 2 card) from an issuing station near to the vending machine including a first authorization information verifying the customer's age and other relevant information such as credit card number,) and comparing this first information with the second information retrieved from the user's credit card to determine the compatibility and validate the purchase of items from the vending machine (see at least Abstract, Fig. 2 and paragraph 0020). The above referred Metcalf's teachings are analogous to those claimed by the applicant in claims 1 and 19 , that is of comparing first and second authorization information and when the first and second authorization information is found compatible then only the system actuates the provision of required items (vending items in Metcalf case and digital data in the applicant's case). Metcalf's teachings when combined with other prior arts as disclosed in patents '640 and '441 would render obvious the limitations of claims 1 and 19.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
6/9/2006